

when certain of such CDs are used, the provision of timing data for a player's operation of a controller, and the execution of a game in coordination with the play of the music CD and the operation of the controller by the player.

**Sagawa et al**

As a preliminary matter, Applicants note that Sagawa et al is assigned to Konami, the assignee of the present application, and describes an earlier version of the present invention, within a general class of products called a "musical action game machine." As such, Sagawa may be considered to be representative of the background of the present invention, as described at pages 1-3 of the present application. Accordingly, many of the key features of the invention are not found in Sagawa.

One key feature is the ability to use a "commercially available music CD." As previously explained to the Examiner, Sagawa et al teaches an approach where a musical action game machine is operative on the basis of the content of a single CD ROM, where the single CD-ROM disk includes music, timing and programming. In other words, this CD ROM is a specialty disk, requiring special manufacture and processing, and is not a "commercially available music CD," as that term is clearly defined in the specification and understood in the art. There is not teaching that the specialty CD-ROM can be played on a standard music CD player.

Thus, one benefit of the presently claimed invention is that the music action game machine can use the common and commercially available music CD found in many different types of stores. This allows an operator to play his/her favorite songs and albums on their home player, portable player, auto and on the game machine without requiring the operator to buy a second special disk for use with the game machine. A second benefit of the present invention is that it does not copy music onto the hard drive or into RAM, thereby avoiding problems with copyright infringement, as discussed in previous Amendments and in the specification. Sagawa loads music from a storage device 56 into RAM, as disclosed at col. 17, lines 38-50).

A second related feature is that the player used in the game machine can be much cheaper than in Sagawa in that it does not have to be constructed to identify and decode special programming, timing and music data on the single disk. In comparing Sagawa et al to the present invention, the Examiner states that Sagawa includes "means to play music from a commercially available music CD", with reference to the disclosure in the Abstract and at col. 9,

lines 37-46, with particular reference to element 56 in Fig. 6. However, the text at column 9 merely indicates that the combination of music, timing and programming that is used in Sagawa et al may be contained on a CD ROM. As already noted, the combination of such data would not be on a “commercially available music CD,” as that term is clearly defined in the specification. Further, Sagawa et al states a preference for the auxiliary storage device 56 to be a high capacity hard drive, and not a CDR (col. 13, lines 46-49) Further, for the two embodiments discussed separately at col. 14, lines 5-56 and col. 20, lines 34-52, the auxiliary storage device 56 is described storing (1) BGM , (2) performance data for defining a procedure or a performance operation with respect to each musical composition, (3) various sound effects and (4) data tables. Clearly, device 56 is not one that plays commercially available music CDs. Finally, we would note that a hard drive is a read-write medium. Thus, nothing in Sagawa et al suggests that a standard read-only music CD is to be played.

The Examiner also asserts that the operation timing data storage means is disclosed at col. 3, lines 26-42 and col. 8, line 46-col. 9, line 46 of Sagawa et al. While Sagawa et al is concerned with providing operation timing data for coordination of a player’s operation of an operation member, this feature is not compatible with a commercially available music CD. In other words, the auxiliary storage device 56 or possibly RAM 54 or ROM 55 in Fig. 6, does not represent a storage for operation timing data related to the play of music from a commercially available music CD. The generation of timing data with a commercially available music CD would clearly used different processing from that used by a device that simply extracts timing data from a specialty CD.

Finally, the Examiner asserts that there is a “music game execution means” disclosed in the same portions of the specification in Sagawa et al. Again, there is clearly no teaching of an execution on the basis of music read from a commercially available music CD, which offers special challenges over the execution of a game by reliance on programming and timing stored directly on the CD.

The Examiner acknowledges that Sagawa does not teach at least a judgments means for reading the recorded content of a commercially available music CD and determining whether it is a predetermined type CD based on recorded music content. For this feature, the Examiner must look to Olmedo.

### Olmedo

The patent to Olmedo discloses a Karaoke machine, whose purpose (allowing singers to follow lyrics on a screen as background music is played) and focus (generating the music and lyrics without regard to the input of a singer) is wholly different from that of a music game machine (interactive and competitive game play). While Olmedo plays music from a CD, they typically are specialized CD's having music, programming and timing embedded on a single disk, as taught with respect to the first embodiment. There is a second embodiment, as subsequently discussed, that uses standard CD's but requires a second specialized timing CD as well. In neither case is there a judgment means taught with respect to the first or second embodiments of Olmedo.

Moreover, the Olmedo system provides text of a song on a display, but it does not provide "operation timing data" indicative of timings at which a player should operate a controller in accordance with the game music. Singing the song is not operating a controller. The term "controller" has a conventional meaning in the art and indicates that a player is providing input to a game machine. A microphone on a Karaoke machine is not a game machine controller. The Examiner acknowledges that Olmedo "seems to lack a teaching of a player operating a controller to provide an input to the game based upon operation instructions provided to a player". The Examiner asserts that one could argue that singing into a microphone provides an input to a controller for a Karaoke game. Clearly this is not the case as already noted.

Further, because of the significant differences in purpose and operation between the two references, Olmedo would not be combinable with Sagawa et al in a manner that would render the invention obvious. As to the first embodiment of Olmedo, which uses a special disk having music, programming and timing, the one commonality with Sagawa et al is the use of such specialty disk. The use of a single specialty disk in Olmedo does not lead one of ordinary skill to use a commercial music CD. Moreover, neither this common feature nor anything else would lead to the combination of a game machine and a Karaoke machine. As to the second embodiment, which requires text information to be recorded on a storage medium that is separate and apart from the recording disk on which the audio data is stored, as disclosed beginning at col. 8, line 25, this also does not lead Sagawa et al to use a commercially available music CD. First, use of a music CD would require the additional use of a second storage disk. The use of

separate storage disks where information must be downloaded onto RAM or ROM and then used subsequently in connection with the play of a separate CD music disk is not consistent with the teachings in Sagawa et al of a single disk having timing, programming and music, nor with the goal of the present invention, which attempts to avoid storage of copyrighted data. Thus, there is no motivation for Sagawa to adopt the approach of the second embodiment in Olmedo.

In short, Applicants submits that Sagawa et al and Olmedo are directed to completely different and incompatible systems. There is no teaching or suggestion that one would wish to combine a music game with a Karaoke player. In fact, the use of the two systems involve totally different activities of the participants, as is well known in the art. And, even if combined, the present invention would not be achieved.

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sagawa et al in view of Olmedo and further in view of Ng (6,328,570) This rejection is traversed.

#### Ng

The newly cited reference to Ng does not remedy the deficiencies of Sagawa et al alone or in combination with Olmedo. As noted by the Examiner, Ng teaches a portable Karaoke unit where a song and program data are stored and retrieved from different sources. The Examiner considers the references to be analogous, however, as already noted, a Karaoke player is totally different from a music game of the type disclosed in Sagawa and the subject of the present invention. The only reason for citing Ng is to teach downloading of song, lyrics and image from a variety of sources, including the internet. However, the basic problems of Sagawa et al and Olmedo are not remedied by the citation of Ng. Accordingly, the claims should be patentable over this combination of references.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

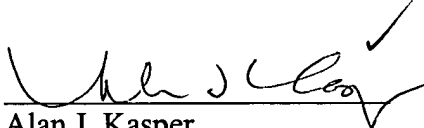
SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

  
Alan J. Kasper  
Registration No. 25,426

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